

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Applicants request that this be considered a petition therefore. Please charge the required fee to Deposit Account No. 14-1263.

ADDITIONAL FEES

Please charge any further insufficiency of fees, or credit any excess to Deposit Account No. 14-1263.

REMARKS

Claims 1-9 were pending. All claims were rejected under 35 USC § 103.

The claims were amended by adding to the preamble of claim 1 functional terminology that distinguishes the claims from the references. None of the claims introduce new matter.

In addition, new claims 10-14 have been added. The new claims do not add new matter.

The references, in combination, do not teach or suggest that the composition may provide superior hairstyling properties. Thus, although Examiner asserts that references may be combined for a different purpose, it is pointed out that the references must still provide for an invention having similar properties to that claimed. *In re Dillon*, 16 USPQ2d 1897 (Fed. Cir. 1990) (en banc).

Penska discloses compositions with at least 50% wt.-% of CO₂-Infused fluorocarbons for the purpose of enhancing blood flow to the skin. More specifically,

Penska's Example 6 discloses a hair and/or skin care composition in the form of an O/W emulsion that further comprises green tea extract. Penska also teaches the addition of UV blockers, including TiO₂.

Kurz's entire disclosure is geared toward sunscreens that provide a broad scope of protection at different wavelengths, from IR to UV to VIS. See Kurz, generally col. 2 to 5.

Examiner has maintained the rejection because she believes that evidence of unexpected results is irrelevant because the references may be combined for a different motivation. Advisory Action 29-July-2004. This conclusion is incorrect. Although references may be combined for a different purpose or utility, the role of unexpected results is clearly, if not always, relevant.

Unexpected results is one way to rebut the presumption of obviousness based on chemical composition's having structural similarity – to show that the claimed invention exhibits some superior property or advantage that a person of ordinary skill in the relevant art would have found surprising or unexpected. *In re Soni* 34 USPQ2d 1684, 1687 (Fed. Cir. 1995). *Soni* says nothing about limiting this rule in relation to the nature of the motivation to combine the references.

The major case that sets out the relationship between combining references and unexpected results for maintaining the rejection over Applicants' unexpected results is *In re Dillon*. *Dillon* states that a *prima facie case* under § 103(a) does not require "a suggestion in or expectation from the *prior art* that the claimed compound or composition will have the same or a similar *utility as one newly discovered by applicant*."¹ (Emphasis in original).

However, the Court also explicitly stated that an applicant's rebuttal "can consist of a comparison of test data showing that the claimed compositions possess unexpectedly improved properties or properties that the prior art do not have" or

¹ *Dillon* at 1901.

"that the prior art is so deficient that there is no motivation to make what might otherwise appear to be obvious changes."²

Thus, even if a composition was suggested by the art for different purposes, or to solve different problems, unexpected results may still indicate that the prior art was "so deficient" in the relevant suggestion to combine the references that such a combination of references would not have been obvious.

On page 11 of the specification is a test wherein hairdressers assessed the effects of the claimed composition. Composition 1, as disclosed in Example 1, and composition 1A are identical except that composition 1A lacks pigment particles, i.e., mica/TiO₂. See page 10, penultimate paragraph. Compositions 1 and 1A were tested in parallel before (a) and after (b) the hair samples were dried. Note that the term "strands" as used here does not relate to single hairs, but to a group or tress of hair.

The results of the experts' opinions based on conventional hair-styling criteria are shown in the table on page 11. The experts' ratings disclose that Composition 1, which included mica/TiO₂ particles, provided substantially superior hair styling properties in comparison to composition 1A.

Even if Penska and Kurz are combined for different reasons, the disclosure still must demonstrate that the properties of the claimed composition would have been reasonably expected. Otherwise, there cannot have been sufficient motivation to combine the references in order to arrive at the claims.

Thus, any hair management benefits imparted by composition 1's inclusion of mica/TiO₂ cannot have been expected based on Kurz's disclosure. Neither Penska nor Kurz refer to hair styling and how to affect it.

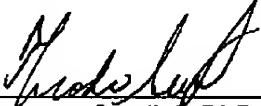
² *Id.*, citing, *In re Albrecht*, 185 USPQ 585, 590 (CCPA 1975) and, *In re Murch* 175 USPQ 89, 91 (CCPA 1970).

Applying the correct legal standard, it is respectfully suggested that the Applicants have shown that their composition cannot be obvious in view of the references. The combined disclosures of Kurz/Penska do not provide any teachings that would have led persons in the art to reasonably expect that the claimed composition would have the unexpectedly superior properties described in the remarks section of the Amendment after final of July 2003.

Therefore, it is requested that in view of the foregoing remarks and amendments, that the rejections under § 103 be withdrawn.

Respectfully Submitted,

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